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09/866,805	05/30/2001	Susumu Honma	109656	5667

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EXAMINER	
KOROBOV, VITALI A	
ART UNIT	**PAPER NUMBER**
2155	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/866,805	HONMA ET AL.	
	Examiner	Art Unit	
	Vitali Korobov	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6,8,9,11 and 13-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6,8,9,11 and 13-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to an RCE filed on 12/08/2005.

2. New claims 16-18 have been added. Claims 1, 3-6, 8, 9, 11, and 13-18 are currently pending.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The applicant's submission filed on 10/19/2005 has been entered.

Claim Objections

4. Claim 17 is objected to because of the following informalities: Claim 17 is incomplete since it ends with a colon. In the interest of speeding up the prosecution of the instant application the Examiner assumed that the colon was meant to be a period.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain new subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 16-18 recite "summary data for each page of each of the plural documents". There is no support for the recited limitation in the specifications. Search for any reference related to "each page" produces one circular reference stating: "Here, the page data pieces are the data pieces contained in each page...", with reference for clarification to Fig. 2, which does not exist in the submitted drawings.

Further, in the first paragraph of the remarks, the Applicants' representative states: "Support for claims 16-18 are found in at least Fig. 2A and pages 10-11 of the original specification". Fig. 2A shows only that "first page" has "page data", providing no support for "summary data for each page of each of the plural documents". Search for explanation on cited pages for item 16A produces a reference to Fig. 2, which does not exist. Review of cited pages 10-11 reveals that the sited pages clearly teach away from the limitations of claims 16-18, showing that the "summary data pieces" group the contents information by subject, not by page, as most clearly seen from such statements as "the detailed description of the invention in the third to ninth pages" and "the embodiments in

the third to ninth pages", etc., which essentially describe what is commonly known as a table of contents in clear contradiction to what is claimed in claims 16-18.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 6, 11, 13, 14 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by the U.S. Patent 5,819,301 issued to Rowe et al., hereinafter Rowe.

With respect to claim 1, Rowe teaches a document data transmission device comprising: storage means for storing plural documents including plural pages (Col. 25, lines 19-22 – storage of documents on server; col. 26, lines 36-37 – storage on server of a plurality of documents; col. 26, lines 7 – 9 – documents may contain plurality of pages); the storage means further storing plural summary data corresponding to the plural documents (Col. 11, line 45 and Fig. 2a – documents have a table of contents and bookmarks), each summary data including information showing which page contains what contents of information (Col. 3, lines 46-48 and lines 55-57 – page content information); page data transmission request receiving means for receiving a page data

transmission request transmitted from a user terminal (Col. 25, lines 10-13, downloading (transmission) request receiving means) requesting to transmit specific page contained in a specific document selected among the plural documents stored in the storage means (Col. 25, lines 15 – 19 – "finder" performs the selection of the document); page data transmitting means for transmitting the specific page contained in the specific document to the user terminal, on the basis of the page data transmission request received by the page data transmission request receiving means (Col. 4, lines 9-12 – user can download a specific page of a document); summary data transmission request receiving means for receiving summary data transmission request transmitted from the user terminal, requesting to transmit a specific summary data selected among the plural summary data stored in the storage means (Col. 25, lines 25-29 – user requests to download a document and receives a header and a range table, containing summary information about the document); and summary data transmitting means for transmitting the specific summary to the user terminal, on the basis of the summary data transmission request received by the summary data transmission request receiving means, wherein the user terminal displays the specific summary data so that a user can select the specific page that includes contents of information of interest to the user (Fig. 10, step 224 – user requests a document. Step 226 – user receives document summary information. Based on the page information determined by the finder (step 230), user downloads a particular page of a document (step 234)).

With respect to claim 5, Rowe teaches a document data transmission reception system comprising: the document data transmission device according to claim 1; and a user terminal for transmitting a summary data transmission request requesting to transmit the specific summary data to the document data transmission device (Fig. 1, computer 10; Col. 9, lines 8-9) and receiving the specific summary data transmitted from the document data transmission device (Col. 25, lines 25-29 – user requests to download a document and receives a header and a range table, containing summary information about the document).

Claim 6 is rejected in view of the above rejection of claim 1, because claim 6 is essentially the same as claim 1, except that said claim 6 sets forth the invention as a document data transmission method rather than a document data transmission device, as does claim 1.

With respect to claim 11, Rowe teaches the document data transmission device of claim 1, wherein the ground-based network comprises the Internet (Col. 2, lines 4-17 – retrieval of documents over the Internet).

With respect to claim 13, Rowe teaches the document data transmission device of claim 1, wherein each page corresponds to at least one of data to be printed out on a single sheet of recording paper and data to be viewed on a single screen of a display (Col. 4, lines 9-12).

With respect to claim 14, Rowe teaches the document data transmission device of claim 1, wherein the page data includes at least one of text data and picture data (Col. 3, lines 55-57).

With respect to claim 16, Rowe teaches the document data transmission device of claim 1, wherein the specific summary data includes summary data for each page of each of the plural documents (Col. 25, lines 19-22 – storage of documents on server; col. 26, lines 36-37 – storage on server of a plurality of documents; col. 26, lines 7 – 9 – documents may contain plurality of pages. Col. 3, lines 46-48 - content information (summary) for individual pages).

Claim 17 is rejected in view of the above rejection of claim 16, because claim 17 is essentially the same as claim 16, except that said claim 17 sets forth the invention as a document data transmission method rather than a document data transmission device, as does claim 16.

Claim 18 is rejected in view of the above rejection of claim 16, because claim 18 is essentially the same as claim 16, except that said claim 18 sets forth the invention as a document data transmission system rather than a document data transmission device, as does claim 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that

the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3, 4, 8, 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe in view of the U.S. Patent 6,775,519 issued to Weideman et al., hereinafter Weideman.

With respect to claim 3, Rowe teaches a document data transmission device according to claim 1.

Rowe does not explicitly teach a billing amount calculating means for calculating a billing amount charged to a transmission of the specific page and to a transmission of the summary data, on the basis of a unit price charged to a transmission of a unit data quantity of the specific page and a unit price charged to a transmission of a unit data quantity of the summary data.

Weideman, an analogous art, describes a system that allows a user to download content via bi-directional communications through a satellite network, and further describes a method and an apparatus a billing amount calculating means for calculating a billing amount charged to a transmission of the specific page and to a transmission of the summary data, on the basis of a unit price charged to a transmission of a unit data quantity of the specific page and a unit

price charged to a transmission of a unit data quantity of the summary data. (Col. 11, lines 59-67 and col. 12, lines 1-7).

It would have been obvious to one having ordinary skills in the art at the time the invention was made to combine selective page download capabilities of Rowe with per page billing features of Weideman in order to provide an improved method and apparatus for accounting for system usage in a connectionless type of satellite communication system, to provide an improved method and apparatus for accounting for session-based system usage in a satellite communication system wherein users employ IP or other types of protocols, and to provide an improved method and apparatus for aggregating system usage data for billing system service providers (Weideman, col. 2, lines 16 – 27).

With respect to claim 4, Rowe teaches a document data transmission reception system comprising: the document data transmission device according to Claim 1; and further discloses a user terminal for transmitting a page data transmission request requesting to transmit the specific page to the document data transmission device through a ground-based network (Col. 2, lines 4-17 – retrieval of documents over the Internet) and receiving the specific page transmitted from the document data transmission device (Col. 4, lines 9-12 – user can download a specific page of a document).

Rowe does not explicitly teach that requested page is being downloaded through a satellite network.

Weiderman teaches a satellite communications system comprising a user terminal (Col. 3, line 20) that receives data for transmitting a page data

transmission request requesting to transmit the specific page data to the document data transmission device (Weideman, col. 3, lines 14 – 22), and receiving the specific page data transmitted from the document data transmission device through a satellite network (Fig. 1).

It would have been obvious to one having ordinary skills in the art at the time the invention was made to combine selective page download capabilities of Rowe and Weideman in order to enhance document receiving capabilities of Rowe by providing an additional path for receiving requested documents.

Claim 8 is rejected in view of the above rejection of claim 3, because claim 8 is essentially the same as claim 3, except that said claim 8 sets forth the invention as a document data transmission method rather than a document data transmission device, as does claim 3.

With respect to claim 9, Rowe teaches a document data transmission system comprising: storage means for storing plural documents including one or plural pages (Col. 25, lines 19-22 – storage of documents on server; col. 26, lines 36-37 – storage on server of a plurality of documents; col. 26, lines 7 – 9 – documents may contain plurality of pages) and plural summary data including contents information of each of the plural document data pieces (Col. 11, line 45 and Fig. 2a – documents have a table of contents and bookmarks), a user terminal for transmitting a page data transmission request (Fig. 1, computer 10; Col. 9, lines 8-9) requesting to transmit the specific page to the document data transmission device through a ground-based network (Col. 4, lines 9-12 – user can request a specific page of a document. Col. 2, lines 4-17 – request of

documents over the Internet), page data transmission request receiving means for receiving a page data transmission request transmitted from a user terminal (process illustrated on Fig. 10), requesting to transmit specific page data contained in specific document data selected among the plural document data pieces stored in the storage means, page data transmitting means for transmitting the specific page data contained in the specific document data to the user terminal, on the basis of the page data transmission request received by the page data transmission request receiving means (Col. 25, lines 15 – 19 – "finder" performs the selection of the document; col. 7, lines 23-27 – selection of a specific page).

Rowe does not explicitly teach that requested page is being downloaded to the user's terminal through a satellite network.

Weiderman teaches a satellite communications system comprising a user terminal (Col. 3, line 20) that receives data for transmitting a page data transmission request requesting to transmit the specific page data to the document data transmission device (Weideman, col. 3, lines 14 – 22), and receiving the specific page data transmitted from the document data transmission device through a satellite network (Fig. 1).

It would have been obvious to one having ordinary skills in the art at the time the invention was made to combine selective page download capabilities of Rowe and Weideman in order to enhance document receiving capabilities of Rowe by providing an additional path for receiving requested documents.

With respect to claim 15, Rowe teaches a document data transmission system of claim 9, further comprising: summary data transmission request receiving means for receiving a summary data transmission request transmitted from the user terminal; requesting to transmit specific summary data selected among the plural summary data pieces stored in the storage means (Fig. 10, step 224 – user requests a particular document), and summary data transmitting means for transmitting the specific summary data to the user terminal, on the basis of the summary data transmission request received by the summary data transmission request receiving means (See Fig. 10, step 226 – user receives document summary information).

9. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

10. Applicants' arguments with respect to claims 1, 3-6, 8, 9, 11, and 13-18 have been considered but they are not persuasive.

The Applicants states - *"As acknowledged by the Patent Office in the November 2, 2005 Advisory Action, Rowe fails to disclose a summary for each page of the document."*

The Examiner respectfully submits that the Patent Office has never acknowledged that. The Applicants misread the cited Action and in their interpretation confuse sufficient and necessary clause.

The Applicants argue - "...neither Rowe, nor Weideman, individually or in combination, discloses or suggests at least summary data including information showing which page contains what contents of information such that a user can select a specific page that includes contents of information of interest to the user, as recited in independent claims 1 and 6."

The Examiner respectfully disagrees. In column 3, lines 46-48 Rowe states: "Page content information that describes individual pages of the document is written in the optimized document file." In column 4, lines 9-12, Rowe further states: "Using the page offset information, a specific page requested by the user is downloaded, and any page desired by the user can readily be downloaded without the necessity of downloading other pages in the document."

The Applicants argue - *"...nowhere does Rowe disclose or suggest that the page content information is included in Rowe's table of contents or bookmarks."*

This argument is moot, since the Examiner never stated in the cited Action that "the page content information is included in Rowe's table of contents or bookmarks." In the Final Rejection cited by the Applicants for this argument, the table of contents and bookmarks are mentioned exactly twice, both times as summary data of the documents, not as summary of individual

pages of the documents. More specifically, table of contents and bookmarks are cited as part of the summary data stored by the storage means, in addition to page summary data, not in place of it, or instead of it, or included in it. This of course does not mean that a table of contents or a bookmark cannot contain a summary of a particular page or point to a particular page.

The Applicants argue - "*At col. 6, lines 47-54, Rowe discloses that the page content information specifies "the appearance of each page of the document," and "any aspect of the appearance of a designated first page of the document at the beginning of the optimized electronic document...."*

Based on this argument, the Applicants arrive at a mistaken conclusion that the information about the appearance of each page is the **only** information about the page stored in the page description of Rowe. The information on page appearance is incorporated into the page description in addition to page content information in order to preserve "an appearance intended by the publisher" (Rowe, Col. 2, lines 12-13). Page appearance information cannot serve as a basis for user's request to download a specific page that Rowe refers to in col. 4, lines 9-12. The Examiner respectfully submits that the user's desire to download a specific page that Rowe repeatedly refers to is not based on the fact that the page is written in a particular font, for example, but because it contains a subject matter of interest to the user.

The Applicants further argue - *"Nowhere does Rowe disclose or suggest that the page content information specifies information showing*

which page contains what contents of information, as recited in independent claims 1 and 6."

The Examiner respectfully disagrees and again refers the Applicants to col. 3, lines 46-48 of Rowe, where Rowe teaches page **content** information, not page **appearance** information, as erroneously interpreted by the Applicants (emphasis added).

The Applicants further argue - *"...none of the applied references disclose or suggest a user terminal for transmitting a page data transmission request through a ground-based network and page data transmitting means for transmitting specific page data contained in the specific document data to the user terminal through a satellite network, as recited in independent claim 9."*

The Examiner respectfully disagrees and refers the Applicants to Microsoft Computer Dictionary, that defines a terminal as a "device consisting of a video adapter, a monitor and a keyboard". Fig. 1 of Rowe shows a user computer system with a keyboard 34 and a display screen 22, which would be able to display anything only if it had a video card, as well known to any person of ordinary skills in the art. Therefore, Rowe discloses a "user terminal", so that the "users may retrieve or download data from Internet network sites". (Col. 2, lines 9-12 of Rowe). Downloading, as any person of ordinary skills in the art would know, is done in response to a request. Internet network sites are known to be ground-based. Ground-based user terminals 13 are also disclosed by Wiederman (Col. 7, lines 1-7), who also discloses satellite network (Fig. 1). The

Examiner respectfully submits that with both ground and satellite networks being disclosed, it is purely an implementation preference how the requests and responses are routed: both through ground network, both through satellite network, or one through satellite, and one through ground network.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SALEH NAJJAR
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Art Unit 2155